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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,716	10/02/2003	Amr Salahieh	1001.1633101	9204

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/677,716

Applicant(s)

SALAHIEH ET AL.

Examiner

Melanie Tyson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to applicant's amendment received on 05 January 2007. All corrections made are accepted.

Response to Arguments

1. Applicant's arguments with respect to claims 1-12, 14-26, 28, and 29 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Daniel et al. (Patent No. 6,245,089 B1). Daniel et al. disclose a medical device for retrieving an intravascular device from a body lumen (Figures 21B and 23A-23E) comprising an elongated shaft member (388) having a proximal section (394) and a distal section (390), a braided member (392; column 17, lines 14-16) coupled to the distal section (394) of the elongated shaft member (388) defining a radially expandable inner lumen (not labeled; see Figure 23E for illustration), and an embolic filter (352) including a filter membrane (344) coupled to a proximal hoop (356) defining a face (not labeled; open portion) having a first position (see Figure 23C) and a second position (see Figure 23E).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3-12, 15, 17-26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Dubrul et al. (Patent No. 6,221,006 B1) in view of Daniel et al. Dubrul et al. disclose a medical device (Figures 8A-8B) comprising an elongated shaft member (21), having a proximal section (not labeled) and a distal section (32), a braided member (column 14, lines 1-4; "multi-braided device" 20) coupled to the distal section of the elongated shaft (Figure 8A), which includes a plurality of filaments ("multi-stranded" polymers and metals; column 14, lines 3-6;) defining a radially expandable inner lumen (22), and an elastomeric jacket encasing at least part of the braided member ("elastomeric covering"; column 14, lines 9-11; silicone and urethane, column 12, line 50). Figure 8B shows the distal end (32) of the elongated shaft member (21) is flared.

Dubrul et al. disclose the braided member (20) is similar in configuration to the embolic protection filter (or TRAP, another braided member disclosed by Dubrul et al.). Dubrul et al. further disclose the plurality of filaments of the TRAP braid are arranged in two sets of parallel helices wound in opposite directions about a common longitudinal axis (a tubular braid that is formed by moving one system of yarn helically clockwise with respect to the axis and another helically counterclockwise; column 15, lines 9-11). Therefore, it is inherent that the plurality of filaments of the braided member described above is also arranged in two sets of parallel helices wound in opposite directions about a common longitudinal axis. However, in the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange two sets of parallel helices wound in opposite directions about a common longitudinal axis as in the TRAP portion taught by Dubrul et al. in order to provide a balanced, torque-free fabric.

Dubrul et al. disclose the TRAP braid is formed of multi-filar threads (a mesh of individual filaments called yarns; column 14, lines 44-45). Therefore, it is inherent that the plurality of filaments of the device described above is also formed of multi-filar threads. However, in the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a plurality of filaments comprising multi-filar threads as in the TRAP portion taught by Dubrul et al. in order to have sufficient strength for entrapping material.

Dubrul et al. disclose platinum (a radiopaque material) may be used in the device described above. Dubrul et al. further discloses the TRAP braid may be formed of composite material (interweaving elastic and inelastic filaments; column 14, lines 44-

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47). Therefore, it is inherent that the plurality of filaments of the braided member described above is also formed of composite material. However, in the alternative, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a plurality of filaments comprising a composite material as in the TRAP portion taught by Dubrul et al. in order to create the particular characteristics desired (elastic, superelastic, etc.).

Although Dubrul et al. disclose the device may be used with a protection filter (or TRAP 13; see Figure 5), Dubrul et al. do not disclose the protection filter includes a support hoop coupled to the filter membrane. Daniel et al. disclose a medical device for retrieving an intravascular device from a body lumen (Figures 21A, B, and/or C and 23A-23E) comprising an elongated shaft member (388) having a proximal section (394) and a distal section (390), a braided member (392; column 17, lines 14-16) coupled to the distal section (394) of the elongated shaft member (388) defining a radially expandable inner lumen (not labeled; see Figure 23E for illustration), and an embolic filter (352). Daniel et al. teach the embolic filter (352) includes a filter membrane (344) coupled to a proximal hoop (356) defining a face (not labeled; open portion) having a first position (see Figure 23C) and a second position (see Figure 23E). It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the protection filter of Dubrul et al. as taught by Daniel et al. in order to provide a support for the filter while forming a lumen filling mouth (column 15, lines 9-11), thus facilitating the capturing of emboli.

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7. Claims 2 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul et al. in view of Daniel et al. as applied to the claims above, and further in view of Zadno-Azizi et al. (Publication No. 2002/0091407 A1).

Dubrul et al. in view of Daniel et al. disclose a device as described above, however, do not disclose the elongated shaft member includes polyether block amide. Zadno-Azizi et al. disclose a system for material containment in a lumen (paragraph 12). Zadno-Azizi et al. teach the elongated shaft member (or catheter shaft) includes polyether block amide (paragraph 88) in order for the shaft to have sufficient structural integrity, or stiffness, to permit the catheter to be pushed through the vasculature to distal arterial locations without buckling or undesirable bending of the body (paragraph 88). Therefore, to include polyether block amide in the construction the elongated shaft member of Dubrul et al. in view of Daniel et al. as taught by Zadno-Azizi et al. would have been obvious to one of ordinary skill in the art at the time the invention was made in order to prevent buckling of the device as it is pushed through the body lumen.

8. Claims 14 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubrul et al. in view of Daniel et al. as applied to the claims above, and further in view of Anderson et al. (Publication No. 2002/0188314 A1).

Dubrul et al. in view of Daniel et al. disclose a device as described above, however, do not disclose the elastomeric jacket includes a radiopaque material. Anderson et al. disclose a device for capturing and removing material from a lumen (paragraph 11). Anderson et al. teach the elastomeric jacket (or polymeric compound that covers the device) may include (or be combined with) a radiopaque material

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(paragraph 60) in order to be able to view the device under fluoroscopy during a medical procedure (paragraph 12). Therefore, to include radiopaque material in the elastomeric jacket of Dubrul et al. in view of Daniel et al. as taught by Anderson et al. would have been obvious to one of ordinary skill in the art at the time the invention was made in order to be able to view the path and/or placement of the device during the procedure.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-

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9062. The examiner can normally be reached on Monday through Friday 9:00 a.m. - 5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson *MT*
February 9, 2007


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
2/12/07